

C. Marie Eckert, P.C., OSB No. 883490

marie.eckert@millernash.com

John C. Clarke, OSB No. 153245

john.clarke@millernash.com

MILLER NASH LLP

US Bancorp Tower

111 SW Fifth Ave, Ste 3400

Portland, OR 97204

Telephone: 503.224.5858

Facsimile: 503.224.0155

Craig D. Leavell, ISB No. 6256260

Admitted Pro Hac Vice

craig.leavell@btlaw.com

Casey G. Campbell, ISB No. 6318370

Admitted Pro Hac Vice

casey.campbell@btlaw.com

Megan M. New, ISB No. 6300422

Admitted Pro Hac Vice

megan.new@btlaw.com

BARNES & THORNBURG LLP

One N Wacker Dr, Ste 4400

Chicago, IL 60606

Telephone: 312.214.4868

Facsimile: 312.759.5646

Mark C. Nelson, TSB No. 00794361

Admitted Pro Hac Vice

mark.nelson@btlaw.com

Daniel A. Valenzuela, TSB No. 24067918

Admitted Pro Hac Vice

daniel.valenzuela@btlaw.com

BARNES & THORNBURG LLP

2121 N Pearl St, Ste 700

Dallas, TX 75201

Telephone: 214.258.4150

Facsimile: 214.258.4199

Attorneys for National Steel Car Limited

UNITED STATES DISTRICT COURT

DISTRICT OF OREGON

PORTLAND DIVISION

NATIONAL STEEL CAR LIMITED, a
Canadian corporation,

Plaintiff,

v.

GREENBRIER-CONCARRIL LLC;
GREENBRIER LEASING COMPANY,
LLC; and GREENBRIER-GIMSA, LLC,

Defendants.

Case No. 3:20-cv-01275-YY

JOINT STATUS REPORT

Pursuant to the Court's scheduling order, the Parties have met and conferred, including two telephone calls and multiple emails, to attempt to narrow the number of asserted claims or prior art references to be asserted at trial.

NSC's Position:

Plaintiff National Steel Car presently intends to assert infringement of the following claims at trial:

US Patent No. 7,434,519, claims 1-4, 8-9, 11, 13-15, 18-19, 22-24

US Patent No. 7,878,125, claims 1, 15-16, 18-19

Plaintiff National Steel Car further intends to submit to the Court evidence in an offer of proof, for purposes of appeal, that the Greenbrier defendants have infringed the following claims under National Steel Car's proposed construction of "side sill":

US Patent No. 7,434,519, claims 12, 16

US Patent No. 7,878,125, claim 11

Plaintiff National Steel Car offered to streamline the case for the jury by focusing on the dependent claims. For example, National Steel Car proposed that the Parties agree that claim 1 of the '519 Patent would not be at issue at the trial, for purposes of either infringement or invalidity. But Greenbrier insisted that it would still pursue its declaratory judgment counterclaim for invalidity of claim 1, even if National Steel Car agreed not to pursue infringement of claim 1 at trial, and instead focus on its dependent claims. Because claim 1 would still be at issue at trial, National Steel Car is unwilling to make such a one-sided agreement. National Steel Car's position is that, if National Steel Car agrees to exclude an asserted claim at trial for purposes of streamlining the case, then Greenbrier's counterclaim as to such a claim should also be excluded at trial.

Greenbrier's Position:

NSC asserted 14 claims in its original Complaint. (Dkt. No. 1). As described above, NSC has not narrowed its asserted claims, and instead presently intends to assert 20 claims.

Greenbrier originally asserted 17 prior-art references in its June 1, 2020 Preliminary Invalidity Contentions. In its July 1, 2022 Expert Report, Greenbrier narrowed its asserted prior art references to 3 primary prior-art references and 3 secondary prior-art references for its invalidity positions, with background references showing the scope and content of the art and knowledge of a person of ordinary skill. Greenbrier presently intends to rely at trial on the narrowed references from its July 1, 2022 Expert Report.

Greenbrier believes that NSC should narrow its 20 asserted claims to reduce the complexity of the case and streamline the issues for summary judgment and trial. *See, e.g., Tabaian v. Intel Corp.*, No. 3:18-CV-326, 2019 WL 1435816 (D. Or. Mar. 29, 2019) (ordering patentee to reduce the number of asserted infringement positions from 13 to 4).

NSC's offer, described in its section above, does not narrow the issues for summary judgment or trial. Using NSC's example, if it "withdraws" only independent claim 1 of the '519 patent, other claims that depend on claim 1—for example claims 3 and 4—would still be at issue. To prove invalidity of such dependent claims, Greenbrier would first be required to prove that underlying independent claim 1 is invalid. *See, e.g., Callaway Golf Co. v. Acushnet Co.*, 576 F.3d 1331, 1344 (Fed. Cir. 2009). Thus, as long as NSC asserts claims that depend on independent claim 1, the substantive issues and evidence presented at summary judgment and/or trial are the same.

Greenbrier remains willing to withdraw its declaratory judgment counterclaims for (i) any claims NSC withdraws that actually narrow the issues; (ii) any entire claim set NSC

withdraws (*i.e.* an independent claim and all claims that depend therefrom); or (iii) any entire patent NSC withdraws.

DATED this 28th day of October, 2022.

/s/ C. Marie Eckert

C. Marie Eckert, P.C., OSB No. 883490
marie.eckert@millernash.com
John C. Clarke, OSB No. 153245
john.clarke@millernash.com
MILLER NASH LLP
US Bancorp Tower
111 SW Fifth Ave, Ste 3400
Portland, OR 97204
T: 503.224.5858 | F: 503.224.0155

Craig D. Leavell (*Pro Hac Vice*)
craig.leavell@btlaw.com
Casey G. Campbell (*Pro Hac Vice*)
casey.campbell@btlaw.com
Megan M. New (*Pro Hac Vice*)
megan.new@btlaw.com
BARNES & THORNBURG LLP
One N Wacker Dr, Ste 4400
Chicago, IL 60606
T: 312.214.4868 | F: 312.759.5646

Mark C. Nelson (*Pro Hac Vice*)
mark.nelson@btlaw.com
Daniel A. Valenzuela (*Pro Hac Vice*)
daniel.valenzuela@btlaw.com
BARNES & THORNBURG LLP
2121 N Pearl St, Ste 700
Dallas, TX 75201
T: 214.258.4150 | F: 214.258.4199

Attorneys for Plaintiff National Steel Car Limited

/s/ Brian Apel

Steven T. Lovett, OSB No. 910701
steve.lovett@stoel.com
Nathan C. Brunette, OSB No. 090913
nathan.brunette@stoel.com
Elliott J. Williams, OSB No. 144835
elliott.williams@stoel.com
STOEL RIVES LLP
760 SW Ninth Ave, Ste 3000
Portland, OR 97205
T: 503.224.3380 | F: 503.220.2480

Marc S. Cooperman (*Pro Hac Vice*)
mcooperman@bannerwitcoff.com
J. Pieter van Es (*Pro Hac Vice*)
pvanes@bannerwitcoff.com
Janice V. Mitrius (*Pro Hac Vice*)
jmitrius@bannerwitcoff.com
Audra C. Eidem Heinze (*Pro Hac Vice*)
aheinze@bannerwitcoff.com
Brian Apel (*Pro Hac Vice*)
bapel@bannerwitcoff.com
Lisa Carlson (*Pro Hac Vice*)
lcarlson@bannerwitcoff.com
BANNER & WITCOFF, LTD.
71 S Wacker Dr, Ste 3600
Chicago, IL 60606
T: 312.463.5000 | F: 312.463.5001

Attorneys for Greenbrier Defendants

CERTIFICATE OF SERVICE

I hereby certify that I served the foregoing Joint Status Report on:

Audra C. Eidem Heinze
aheinze@bannerwitcoff.com
Brian T. Apel
bapel@bannerwitcoff.com
J. Pieter van Es
pvanes@bannerwitcoff.com
Marc S. Cooperman
mcooperman@bannerwitcoff.com
Janice V. Mitrius
jmitrius@bannerwitcoff.com
Lisa S. Carlson
lcarlson@bannerwitcoff.com
BANNER & WITCOFF, LTD.
71 S Wacker Dr, Ste 3600
Chicago, IL 60606

Nathan C. Brunette
nathan.brunette@stoel.com
Steven T. Lovett
steve.lovett@stoel.com
Elliott J. Williams
elliott.williams@stoel.com
STOEL RIVES LLP
760 SW Ninth Ave, Ste 3000
Portland, OR 97205

Attorneys for Greenbrier Defendants

by the following indicated methods on the date set forth below:

- ☒ **CM/ECF system transmission.**
- ☐ **E-mail.** As required by Local Rule 5.2, any interrogatories, requests for production, or requests for admission were e-mailed in Word or WordPerfect format, not in PDF, unless otherwise agreed to by the parties.
- ☒ **E-mail (courtesy copy).**
- ☐ **Facsimile communication device.**
- ☐ **First-class mail, postage prepaid.**
- ☐ **Hand-delivery.**
- ☐ **Overnight courier, delivery prepaid.**

DATED: October 28, 2022.

/s/ C. Marie Eckert

C. Marie Eckert, P.C., OSB No. 883490
Of Attorneys for National Steel Car Limited